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09/900,384	07/06/2001	Shekhar Kirani	LS/0010.00	7192
8791 7590 09/17/2008 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER BENZON, GREG C				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/900,384

**Applicant(s)**

KIRANI ET AL.

**Examiner**

GREG BENZON

**Art Unit**

2144

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 18-33 and 46-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-33, 46-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

This application has been examined. Claims 1-16, 18-33, 46-50 are pending.  
Claims 17, 34-45, 51 are cancelled.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/18/2008 has been entered.

***Priority***

The claimed inventions have been verified with the parent applications 09/588875 filed 6/6/2000 and 60/203407 filed 06/11/2000. The parent applications do not support the claims' subject matter. Hence, they do not entitle this application to a benefit of earliest filing date.

The effective date of the claims described in this application is July 6, 2001.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16, 18-33 and 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabe-Hesketh et al. (WO 00/72534 Applicant) and Moussa et al. (US Patent 6742043) further in view of Bakshi (US Patent 6311215) further in view of what was well-known in the networking art.

Regarding claims 1 Rabe-Hesketh disclosed a method, apparatus and computer program (collectively referred to as "system") for automatically processing e-mail messages containing attachments, the method comprising: receiving a particular e-mail message having a particular attachment; removing the particular attachment from the particular message based on predefined criteria e.g., size of the attachment; inserting a link into the particular e-mail message, said link capable of referencing the particular attachment that has been removed; in response to invocation of the link by the intended recipient, retrieving a copy of the particular attachment that is automatically formatted

based on the specified preference (Rabe-Hesketh - Abstract, Page 3, Lines 25-37; Page 3, Line 24-Page 4, Line 25; Page 5, Line 25-Page 6, Line 25; Page 7, Line 20-Page 11, Line 37).

Rabe-Hesketh does not explicitly disclose specifying a preference for formatting attachments and does not explicitly apply predefined criteria in response to a client's capability, e.g., exceeding client capability. Rabe-Hesketh does not disclose detecting an intended recipient's receiving device during a request from the recipient to retrieve the particular e-mail message and thus formatting attachments accordingly. Rabe-Hesketh does not disclose creating a reformatted attachment based on the specified preference and substituting a link in the email to the reformatted attachment in place of the reformatted attachment

However, in the same field of endeavor, a teaching that has objective akin to Rabe-Hesketh, Moussa teaches a system for communicated media object to an e-mail recipient, which is capable of modifying object format based on specified user preference (Moussa-Column 16 Lines 25-35). Moussa disclosed detecting an intended recipient's receiving device during a request from the recipient to retrieve the particular e-mail message (Moussa-Column 6 Lines 45-65, Column 16 Lines 25-35) and thus formatting attachments accordingly. (Moussa-Column 16 Lines 35-55)

Moussa disclosed creating a reformatted attachment based on the specified preference (Moussa-Column 6 Lines 45-65, Column 16 Lines 25-35).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Rabe-Hesketh by including, the teaching of using user preference and thinning message to accommodate client capabilities as taught by Moussa to enable Rabe-Hesketh's system to provide an object in accordance with user requirement and expand the predefined criteria in Rabe-Hesketh. In doing would enable Rabe-Hesketh's system to enhance its ability and flexibility in providing services to the users that have different levels of resources and capabilities. (Moussa-Column 4 Lines 60-65)

However the combination of Rabe-Hesketh-Moussa-Bakshi does not disclose substituting a link in the email to the reformatted attachment in place of the reformatted attachment.

The Examiner notes that it would have been obvious to a person of ordinary skill in the art that the reference link inserted by Rabe-Hesketh has a one-to-one correlation with the original attachment which said link replaces in the email message. Thus, in the combination of Rabe-Hesketh-Moussa-Bakshi where the original attachment is no longer the desired content, it would have been obvious to a person of ordinary skill in the networking art to substitute a link in the email to the reformatted attachment in place of the reformatted attachment.

Furthermore the combination of Rabe-Hesketh-Moussa-Bakshi does not disclose (re. Claim 1) receiving a request for a copy of the reformatted attachment wherein the request includes transformation parameters that indicate how to transform the particular attachment to the reformatted attachment.

Bakshi disclosed (re. Claim 1 ) receiving a request for a copy of the reformatted attachment wherein the request includes transformation parameters that indicate how to transform the particular attachment to the reformatted attachment. (Bakshi-Column 2 Lines 65 thru Column 3 Lines 1-25, Column 7 Lines 5-40, Column 7 Lines 60 thru Column 8 Lines 15)

At the time of the invention it would have been obvious to combine Bakshi into Rabe-Hesketh-Moussa. The motivation for said combination would have been to allow network client 12 to receive the correctly-transcoded content even if the HTTP remote proxy 36 to which it is coupled changes due to, for example, a change in geographical location of network client 12 or network load-balancing procedures. (Bakshi- Column 7 Lines 60 thru Column 8 Lines 15)

Claims 4-6, 18, 26, and 46 are rejected on the same basis as Claim 1.

Regarding claims 26 the Examiner notes Rabe-Hesketh-Moussa-Bakshi, in combination with what was well-known in the networking art disclosed '*generating a reference allowing retrieval of a transformed copy of the detached object*'.

The Examiner notes that it would have been obvious to a person of ordinary skill in the art that the reference link inserted by Rabe-Hesketh has a one-to-one correlation with the original attachment which said link replaces in the email message. Thus, in the combination of Rabe-Hesketh-Moussa-Bakshi where the original attachment is no longer the desired content, it would have been obvious to a person of ordinary skill in the networking art to substitute a link in the email to the reformatted attachment in place of the reformatted attachment.

Furthermore Rabe-Hesketh-Moussa-Bakshi disclosed (re. Claim 46) a transformation module for transforming the objects of the attachment to a desired format, based on capabilities of the target device; (Moussa-Column 6 Lines 45-65, Column 16 Lines 45-65).

Regarding claims 2 and 3, Rabe-Hesketh-Moussa-Bakshi disclosed, preference is associated with a particular user (Moussa-Column 6 Lines 45-65).



Regarding claims 7, 8 and 27, Rabe-Hesketh-Moussa-Bakshi disclosed preference includes specifying that attachments which comprise images be transformed from one file format to another (Moussa-Column 6 Lines 45-65)

Regarding claim 9 and 49, Rabe-Hesketh-Moussa-Bakshi disclosed receiving the particular message at an SMTP server (Rabe-Hesketh, Page 4, Lines 21-26).

Regarding claim 10-11, Rabe-Hesketh-Moussa-Bakshi disclosed removing attachment could be done at anywhere server including a mail server or at MTA, which employed SMTP protocol. (Rabe-Hesketh, Page 4, Lines 21-26)

Implicitly, Rabe-Hesketh-Moussa-Bakshi has readily taught removing an attachment at SMTP server or by the SMTP server.

Regarding claims 12-14, 47-48, Rabe-Hesketh-Moussa-Bakshi disclosed message includes a MIME attachment (Rabe-Hesketh - Page 3, Lines 24-37).

Regarding claims 15 and 33, Rabe-Hesketh-Moussa-Bakshi disclosed link comprises a Uniform Resource Locator (URL) referencing said attachment that has been removed (Rabe-Hesketh Page 6, Lines 2-8; Page 12, Lines 18-30).

Regarding claims 16, 19-20 and 28, Rabe-Hesketh-Moussa-Bakshi disclosed copy of the particular attachment is automatically formatted when a request is received to retrieve the particular attachment (Moussa-Column 6 Lines 45-65)

Regarding claims 21-22, 26,29 , Rabe-Hesketh-Moussa-Bakshi disclosed reformatting resolution, fidelity, color. (Moussa-Column 9 Lines 55-60)

Regarding claims 23, 30, Rabe-Hesketh-Moussa-Bakshi disclosed formatted copies of objects within the particular attachment are stored in a network repository (Rabe-Hesketh Fig. 2, storage 27).

Regarding claim 24, Rabe-Hesketh-Moussa-Bakshi disclosed network repository is accessible by a Web browser for shared access among multiple participants (Rabe-Hesketh Fig4, 48; Fig 5A-5C).

Regarding claims 25, 31 and 32, Rabe-Hesketh-Moussa-Bakshi disclosed attachment includes JPEG-formatted digital images (Moussa-Figure 6).

Rabe-Hesketh-Moussa-Bakshi disclosed (re. Claim 50) wherein said attachment processing module operates as a plug-in module to said e-mail server. (Rabe-Hesketh-Page 21 Lines 15-25, Page 22 Lines 30-35)

***Response to Arguments***

Applicant's arguments filed 06/18/2008 have been considered but are not persuasive.

The Applicant presents the following argument(s) [*in italics*]:

*[The prior art] does not disclose substituting a link in the email to the reformatted attachment in place of the reformatted attachment.*

The Examiner respectfully disagrees with the Applicant.

The Examiner notes that it would have been obvious to a person of ordinary skill in the networking art that the reference link inserted by Rabe-Hesketh has a one-to-one correlation with the attachment which said link replaces in the email message. Thus, in the combination of Rabe-Hesketh-Moussa-Bakshi where the original attachment is no longer the desired content to be presented to the target client device, it would have been obvious to a person of ordinary skill in the networking art to substitute a link in the email to the reformatted attachment in place of the reformatted attachment.

The Examiner believes that in the arguments presented 12/31/2007 the Applicant has misinterpreted the comments above.

As stated in the rejection Rabe-Hesketh is NOT relied upon for creating a reformatted attachment based on the specified preference and substituting a link in the email to the reformatted attachment in place of the reformatted attachment. Thus the Examiner remark regarding 'a one-to-one correlation with the attachment which said link replaces in the email message' is not referring to any reformatted attachment but rather to Rabe-Hesketh (Page 12 Lines 20-30 ) 'replacing the attachment with a reference'. In this context the prior art by Rabe-Hesketh is still talking about the original attachment, not the reformatted attachment.

The Examiner would like to restate that in Rabe-Hesketh there is 'a one-to-one correlation with the [original] attachment which said link replaces in the email message'.

Upon combining the teachings by Moussa into Rabe-Hesketh and creating the reformatted attachments as taught by Moussa, the Examiner notes that there is no suggestion or requirement by either prior art of deleting the original attachment by Rabe-Hesketh, meaning that the original attachment and original URL reference for the original attachment is maintained.

Moussa disclosed creating a substitute file as embodied by a reformatted attachment.(Moussa Column 16 Lines 35-65)

Given the one-to-one correspondence between the original attachment file and original URL, and in context of creating the substitute/reformatted attachments as taught

by Moussa, it would have been obvious to a person of ordinary skill in the networking art such as Rabe-Hesketh to create a substitute URL for referencing the substitute/reformatted attachment file. Furthermore it would have been obvious to use the substitute URL in the email message in replacement of the substitute/reformatted attachment file.

The Applicant presents the following argument(s) *[in italics]*:

*Applicant respectfully traverses the Examiner's assertion of Official Notice and further requests documentary evidence supporting Examiner's Official Notice.*

The Examiner would like to restate that in Rabe-Hesketh there is 'a *one-to-one correlation with the original attachment which said link replaces in the email message*'.

See Chapter 19 and Chapter 22 How URL's Work, How the Internet Works, by Preston Gralla, QUE Publishing.

The Applicant presents the following argument(s) *[in italics]*:

*... neither Rabe-Hesketh nor Moussa disclose or suggest, "wherein the request includes transformation parameters that indicate how to transform the particular attachment to the reformatted attachment" as recited in claim 1, Applicants' receiving a request is supported in Figure 6, block 601 and at Page 37, Lines 23 - 28.*

The Examiner presents prior art by Bakshi disclosing *wherein the request includes transformation parameters that indicate how to transform the particular*

*attachment to the reformatted attachment.* (Bakshi-Column 2 Lines 65 thru Column 3 Lines 1-25, Column 7 Lines 5-40, Column 7 Lines 60 thru Column 8 Lines 15)

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to the enclosed PTO-892 form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Greg Bengzon/  
Patent Examiner, Art Unit 2144